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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,346	02/24/2004	Gopinath Ganapathy	35417-8003.US00	3841

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EXAMINER

ROBERTSON, DAVID

ART UNIT PAPER NUMBER

3623

MAIL DATE DELIVERY MODE

06/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,346

Applicant(s)

GANAPATHY ET AL.

Examiner

Dave Robertson

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This is a Restriction Only action over pending claims 1-29 after the successful filing of a "Petition to Revive after Unintentional Abandonment", granted 6/18/2007.

Examiner Note

2. The prosecution of this application has been forwarded to a new examiner. Whereas the former examiner did not assert a restriction requirement over the original claims, initial search and consideration of the presented claims by the current Examiner makes clear the divergent subject matter and, particularly, the divergent focus of patentability in the claims as currently presented.
3. To further prosecution on the merits, Examiner also indicates in this action the presence of potentially new subject matter in the amended claims. Applicant is afforded in response the opportunity to review the restriction requirement and the assertion of new matter in the amend claims, and in response traverse, amend or acknowledge as deemed appropriate.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. Claims 1-9, drawn to an automated system for facilitating and monitoring the design of an end product, the system incorporating design tools, a project planning tool, and an enterprise resource planning tool, the monitoring results in the updating of a schedule based on the current status of the project, classified in class 705, subclass 8.
 - II. Claims 10-27, drawn to an automated system for monitoring the status of a distributed team, hierarchically-structured product design project, by monitoring events and triggering activity based on rules and event conditions, and creating a schedule based on the events monitored, classified in class 705, subclass 8.
 - III. Claims 28 and 29, drawn to an automated method of monitoring cost and completion status of an ongoing electronic design project and updating a schedule based on the comparison of actual to estimated cost to monitoring, classified in class 705, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

5. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the

particulars of the subcombination as claimed because Invention I does not require the particulars of the monitoring engine for patentability of integrating design tools, project planning tools, and human resource tools for facilitating a design project. The subcombination has separate utility such as providing for maintaining consistency in design software tool data across a distributed design team.

6. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because Invention I does not require the particulars of the monitoring engine for patentability of integrating design tools, project planning tools, and human resource tools for facilitating a design project. The subcombination has separate utility such as providing a method to estimate a more accurate schedule for a current project using metrics from completion status of the project in comparison to the original schedule.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or

includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

7. Inventions II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination of Invention III has separate utility such as providing a method to more accurately estimated an updated project schedule using status metrics from project in comparison to the estimated metrics. See MPEP § 806.05(d).

The examiner has required restriction between subcombinations usable together. Where applicant elects a subcombination and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their

recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. A courtesy call by telephone voice message was left with Attorney Shaalu Mehra on 6/19/2007 indicating that a restriction requirement would be made on this application, and that, given the Attorney's indication that both he and the Examiner would be alternately out of the office over the next few business days, a written requirement would be made.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103 (a) of the other invention.

Response to Amendment

9. The amendment filed 2/21/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is found in the amended claims as follows:

Applicant amends claims 1, 10 and 28 to recite creating (or updating) a schedule according to a current state (claim 1), an occurrence of an event (claim 10), or to comparing of actual cost to the percentage of completion of a project (claim 28); however, none of the original disclosure, the priority provisional application, or the original claims supports a claim to creating or updating a schedule during project monitoring (after initial Project Planning) according to a current state, an event, or actual costs in comparison to completion percentage.

A detailed review of the provisional and non-provisional disclosures including claims as originally presented, shows support for schedule monitoring and warning of failures to meet schedules, and highlighting discrepancies between actual and expected status and cost; however, no creating or updating of a project schedule based on current state, event, or actual cost is disclosed.

Applicant is required to cancel the new matter in the reply to this Office Action, or to indicate where in the disclosure the limitations are explicitly supported, or where such limitations are at least suggested by the disclosure to one of ordinary skill in the art.

Response to Arguments

10. Applicant's arguments filed 2/21/2007 have been fully considered, however, Examiner reserves a full response to Applicant's arguments as to the merits pending response to the restriction requirement and remarks above. Applicant is also afforded the opportunity to maintain, revise, or amend in a supplemental amendment. Based on Applicant's election and on an initial and preliminary search and consideration of the currently presented claims, Examiner anticipates examination on the merits anew, and a non-final action over new grounds of rejection.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Robertson whose telephone number is 571-272-8220. The examiner can normally be reached on 8:15am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

dcr

dcr
6/19/07



**C. MICHELLE TARAE
PRIMARY EXAMINER**